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7590 03/01/2011 MANELLI DENISON & SELTER PLLC 7th Floor 2000 M Street, N.W. Washington, DC 20036-3307			EXAMINER BARQADLE, YASIN M	
			ART UNIT 2456	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/852,848

**Applicant(s)**

ARNESON ET AL.

**Examiner**

YASIN BARQADLE

**Art Unit**

2456

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7,8,26-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,8,26-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **Response to Amendment**

The amendment filed on December 09, 2010 has been fully considered but are not deemed persuasive.

- Claims 7-8 and 26-28 and 30-32 are presented for examination.

### **Response to Arguments**

Regarding claims 26, 28-30, and 32, the Applicant argues "Chack's transaction processing system is **only able** to service the **URL** that is transmitted to a transaction initiator. Thus, to modify Chack's transaction processing system to transmit a data message that comprises a **phone number** would be **nonsensical** within the context of Chack's invention - which **lacks** a system and method that is able to **service** a call from the phone number." (Page 7 forth paragraph).

The Examiner disagrees with Applicant's assessment that Chack is **only able to service a URL**. Here is what Chack is able to service "A transaction processing system is **any device capable of receiving, transmitting, queuing, routing, or otherwise processing a transaction**. A transaction processing system may **also handle mixed transactions** (e.g., **receive a telephone call** and respond to the telephone call **using electronic mail**). ... Exemplary transactions **include telephone calls, video sessions, or an Internet session**. ... those of ordinary skill in the art will appreciate that the teachings of the invention **can be applied to**

any type of transaction. In particular, the teachings of the present invention may be applied to any type of real-time transaction. "(Col. 4, lines 13-31). As such there is nothing **nonsensical** with the Examiner's suggested modification of Chack since Chack is capable of receiving, transmitting, queuing, routing, or otherwise processing a transaction and since Chack can handle mixed transactions (e.g., receive a telephone call and respond to the telephone call using electronic mail).

It appears that the Applicant is also arguing that the Helferich does not teach "user-specified pre-designated information" (Page 8 fourth paragraph).

The Examiner notes the applicant is arguing against the references individually. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Chack is relied upon to teach the limitation of "user-specified pre-designated information". For example, Chack teaches "In other embodiments of the invention, the transaction processing system identifies the telephone number or other identifier associated with a received call. Based on information known about the call initiator, the transaction processing system determines whether to automatically provide a URL to the call initiator. For example, customers of an organization operating the transaction processing system may notify the

organization that they have the capability to receive and utilize a URL. The organization maintains a table of such customers based on the customer's telephone number, account number, or other identifying information. If the transaction processing system receives a call from a customer listed in the table, then the transaction processing system automatically provides a URL to the customer." (col. 7, lines 9-22).

Chack further teaches "When the transaction processing system receives a request from a telephone caller for a URL (or otherwise determines that the caller can receive URLs), the transaction processing system may generate a custom web page for the caller having a unique URL. That URL is provided to the caller, thereby allowing the caller to view the custom web page on the caller's computer. The custom web page may contain, for example, information regarding the caller's account balance or information regarding pricing and availability of various products of interest to the caller." (col. 7, lines 40-49).

Therefore, Chack clearly teaches the argued limitation including providing user-specific pre-designated information with call related information relating to a first device (call initiator).

Chack also teaches A user-specific pre-designated information (such account balance and other information desired) is provided to a call initiator in response to a call without a need to answering said call from a first device (col. 7, lines 9-49 and col. 7, lines 61-65 and col. 8, lines 61-63).

Same response applies to arguments related to claims 7, 8, 27 and 31 over Pepe, Chack and Helferich.

Regarding claims 7 and 8, the Applicant argues “Makela fails to teach or suggest a method for triggering transmission of data message comprising a phone number to calling device according to a user specified pre-designated information to the calling device” page 11 third paragraph.

Again the applicant seems arguing against the references individually. However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combined references of Makela, Chack, and Helferich teach the argued limitations. The Applicant is directed to above response and the detailed office rejection below.

Regarding the elements of “associating user-specific pre-designated information”, the examiner has addressed how Chack meets this limitation. The Applicant is referred to the above response.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chack USPN. (6751211) in view Helferich (6636733).

As per claim 26, and 30 Chack teaches a method of retrieving information by a first device (Fig. 3, 60) from a second device (fig. 3, 68), comprising:

formulating and storing a user specific retrieval profile designating a user specified pre-determined information relating to a calling communication device "In other embodiments of the invention, the transaction processing system identifies the telephone number or other identifier associated with a received call. Based on information known about the call initiator, the transaction processing system determines whether to automatically provide a URL to the call initiator. For example, customers of an organization operating the transaction processing system may notify the organization that they have the capability to receive and utilize a URL. The organization maintains a table of such customers based on the customer's telephone number, account number, or other identifying information. If the transaction processing system receives a call from a customer listed in the table, then the transaction processing system automatically provides a URL to the customer." (col. 7, lines 9-22);

receiving a call together with call related information from a calling communications device calling a first telephone number (a telephone caller

initiates a call to a telephone number associated with a transaction processing system col. 7, lines 61-63. See also col. 9, lines 43-46 and the abstract);

terminating said call from said first calling device before answering (the transaction processing system provides a URL to the telephone caller without answering the call (col. 7, lines 61-65 and col. 8, lines 61-63);

associating a data with said call related information of said calling communication device “When the transaction processing system receives a request from a telephone caller for a URL (or otherwise determines that the caller can receive URLs), the transaction processing system may generate a custom web page for the caller having a unique URL. That URL is provided to the caller, thereby allowing the caller to view the custom web page on the caller's computer. The custom web page may contain, for example, information regarding the caller's account balance or information regarding pricing and availability of various products of interest to the caller” (col. 7, lines 9-49);

in response to detecting said call related information, triggering transmission of said data according to said user specific retrieval profile (“The transaction processing system provides a URL to the telephone caller. The web page associated with the URL contains information requested by the caller” (col. 7, lines 9-32 and col. 7, lines 61-65; col. 8, lines 61-63 and col. 9, lines 46-48); and



Regarding claims 26 and 30, although Chack shows substantial features of the claimed invention including transmitting retrieved user-specific pre-designated information (requested URLs according to caller's capability) to a telephone number as explained above, Chack does not explicitly show a data message comprising a phone number.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chack, as evidenced by Helferich (6636733).

In analogous art, Helferich whose invention is about wireless messaging system, discloses a data message comprising a call back phone number (col. 4, lines 54 to col. 5, line 6). Giving the teaching of Helferich, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chack by employing the messaging system of Helferich in order deliver desired data message to subscribers according to their preferred profile.

Helferich further teaches in response to a second call to said second phone number transmitting said user specified pre-designated information to said call communication device (col. 5. lines 1-25 and steps 220-222 figure 2B).

As per claims 28 and 32 Chack teaches a method of retrieving information by a first device from a second device, further comprising:

determining said second telephone number from call related information

associated with said call to said second telephone number by said calling communication device [col.6, 11-18 and col. 8, lines 24-32].

Claims 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chack USPN. (6751211) in view Helferich and further in view of Pepe et al USPN (5742668).

Regarding claims 27 and 31, although Chack and Helferich show substantial features of the claimed invention as explained in claims 26 and 30 above, they do not explicitly show converting retrieved user information to short message and transmitting to calling device.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Chack and Helferich, as evidenced by Pepe (5742668).

In analogous art, Pepe et al whose invention is about a network which provides a variety of electronic text delivery, receipt, and notification options system, disclose converting retrieved user information to short message and transmitting to calling device (col. 21, lines 40-52; col. 24, line 1-8 and col. 27, lines 1-8). Giving the teaching of Pepe et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Chack and Helferich by employing the system of Pepe et al in order deliver a desired information to subscribers based on delivery format according to user's

profile and to devices of the subscriber's choice capable of receiving short message information.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makela USPN. (6301338) in view of Chack USPN. (6751211) and further in view of Helferich (6636733).

As per claims 7 and 8, Makela teaches the method of providing electronic mail notification to a communications device (abstract), comprising:

associating an email with said call related information of said calling communication device (col. 3, lines 27-46 and col. 8, lines 30-36); and

in response to detecting said call related information, automatically fetching said email to said calling communication device and transmitting said data according to said user specific retrieval profile (col. 5, lines 2-11; col. 3, lines 27-46; col. 5, lines 31-36 and col. 8, lines 30-36).

Regarding claims 7 and 8, Makela shows substantial features of the claimed invention including sending SMS and/or an email message to caller's associated email address automatically (col. 3, lines 27-46 and col. 8, lines 30-36). However, Makela does not explicitly show where the message includes caller specified pre-designated information.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Makela, as evidenced by Chack.

In analogous art, Chack disclose “When the transaction processing system receives a request from a telephone caller for a URL (or otherwise determines that the caller can receive URLs), the transaction processing system may generate a custom web page for the caller having a unique URL. That URL is provided to the caller, thereby allowing the caller to view the custom web page on the caller's computer. The custom web page may contain, for example, information regarding the caller's account balance or information regarding pricing and availability of various products of interest to the caller” (col. 7, lines 40-49). Giving the teaching of Chack a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Makela by employing the system of Chack in order to provide identified calling customers immediately with information that is pertinent to their call.

Chack further teaches formulating a user specific retrieval profile designating user specified pre-determined information relating to a call communications device “In other embodiments of the invention, the transaction processing system identifies the telephone number or other identifier associated with a received call. Based on information known about the call initiator, the transaction processing system determines whether to automatically provide a URL to the call initiator. For example, customers of an

organization operating the transaction processing system may notify the organization that they have the capability to receive and utilize a URL. The organization maintains a table of such customers based on the customer's telephone number, account number, or other identifying information. If the transaction processing system receives a call from a customer listed in the table, then the transaction processing system automatically provides a URL to the customer." (col. 7, lines 9-22).

As to claims 7 and 8, although Makela and Chack show substantial features of the claimed invention, Makela and Chack do not explicitly show a data message comprising a phone number to a calling communication device according to a user specific retrieval profile.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Makela and Chack, as evidenced by Helferich (6636733).

In analogous art, Helferich whose invention is about wireless messaging system, discloses a data message comprising a call back phone number (col. 4, lines 54 to col. 5, line 6). Giving the teaching of Helferich, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Makela and Chack by employing the messaging system of Helferich in order deliver desired data message to subscribers according to their preferred profile.

Helferich further teaches in response to a second call to said second phone number transmitting said user specified pre-designated information to said call communication device (col. 5, lines 1-25 and step 220-222 figure 2B).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al USPN (5742668) in view of Chack USPN. (6751211) and further in view of Helferich (6636733).

As per claim 7, Pepe et al teach the method of providing electronic mail notification to a communications device, comprising:

formulating a user specific retrieval profile designating a message delivery format and user specified pre-determined information for said calling communications device (col. 5, lines 33-63 and col. 19, lines 32-52. See also col. 21, lines 40 to col. 22, line 16);

associating an email with a first phone number (the number called by the subscriber) receiving a call from a communications device (subscriber portable device 32) [col. 21, 15-67]; and using call related information from said call to automatically identify (col. 6, lines 47-65 and col. 21, lines 18-67] and provide said email to said communications device after said communications device calls a first phone number [col. 7, lines 30-46 and col. 21, lines 18-67]. Although Pepe et al shows substantial features of the claimed invention including providing emails to a communication device, he does not explicitly

show in response to detecting a caller ID, automatically transmitting desired information to a device before answering a call.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pepe et al, as evidenced Chack USPN. (6751211).

In analogous art, Chack whose invention is about a method for communicating information discloses a transaction processing system that provides a desired information (a URL) to a caller in response to detecting a caller ID and before answering the call (col. 7, lines 61-65 and col. 8, lines 61-63). Giving the teaching of Chack, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Pepe's email providing system by employing the method providing information to a telephone caller without answering the call of Chack. One ordinary skill in the art would do so because the transaction processing system does not answer the incoming call therefore no connection charges are incurred since no connection was established.

As to claims 7 and 8, although Pepe and Chack show substantial features of the claimed invention, Pepe and Chack do not explicitly show a data message comprising a phone number to a calling communication device according to a user specific retrieval profile.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pepe and Chack, as evidenced by Helferich (6636733).

In analogous art, Helferich whose invention is about wireless messaging system, discloses a data message comprising a call back phone number (col. 4, lines 54 to col. 5, line 6). Giving the teaching of Helferich, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Pepe and Chack by employing the messaging system of Helferich in order deliver desired data message to subscribers according to their preferred profile.

Helferich further teaches in response to a second call to said second phone number transmitting said user specified pre-designated information to said call communication device (col. 5. lines 1-25).

As per claim 8, Pepe et al teach the method of providing electronic mail notification to a communications device according to claim 7, further comprising:

obtaining a communications device identifier when said communications device dials said first phone number, and using said communications device identifier to select said electronic mail message [col. 14, lines 46-63 and col. 21, 40-65].



### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dharia Rupal can be reached on 571-272-3880. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yasin M Barqadle/  
Primary Examiner, Art Unit 2456